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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,860	06/09/2001	George Michael Mockry	530.005PA	8653

22907 7590 06/28/2005

BANNER & WITCOFF  
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WASHINGTON, DC 20001

EXAMINER
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CHAMBERS, MICHAEL S

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SA

**Office Action Summary**

Application No.

09/878,860

Applicant(s)

MOCKRY ET AL.

Examiner

Mike Chambers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23-40 are rejected under 35 U.S.C. 103(a) as obvious over SeasonTicket in view of Rangan et al. SeasonTicket discloses recording personalized sport video highlight shows (page2 2<sup>nd</sup> paragraph). The duration and subject matter recorded is a matter of design choice to the viewer. The specification provides no unexpected results in recording the action plays of the game. The content of an edited video contains no patentable novelty. It would have been obvious to one of ordinary skill in the art at the time of the invention to have edited and recorded the video to reflect what the viewer wished to record based on personal preferences. This requires no patentable skill. The method claimed would naturally be used when the video was produced and played. Although SeasonTicket makes reference to the fact that video highlights were pre-selected by the user, which one may infer the user was a subscriber, it is not clear (Note the second reference for season ticket, notes in the 6<sup>th</sup> paragraph that the video highlights were pre-selected by the user which would indicate there was a subscription service). Rangan et al discloses the use of subscribers is well known in the art (5:50-64,23:32-40). It would have been obvious to one of ordinary skill in the art at the time of the invention to included obtaining subscribers in order to increase the profitability of the business.

As to claim 24: See claim 23 rejection. The decisions to record each appearance at bat for every player, the final pitch thrown to each player and successful and unsuccessful attempts by the base runners are design choices based on editing decisions by the editor. The specification provides no unexpected or surprising results in recording the action plays of the game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have edited the video to reflect what the editor wished to record based on personal preferences. The method claimed would naturally be used when the video was produced and played.

As to claim 25: The length of time recorded is considered a design choice. No criticality is seen in the duration of the edited recording. The duration of the edited recording is a matter of design choice as the specification provides no unexpected or surprising results in using a edited recording of about 15 minutes. It would have been obvious to one of ordinary skill in the art to have selected an appropriate length of time for the video to run based on cost and design considerations. The method claimed would naturally be used when the video was produced and played.

As to claim 26: The portion of the game recorded is considered a design choice. No criticality is seen in the portion of the game recorded. The portion of the game recorded is a matter of design choice as the specification provides no unexpected results for recording a portion of a nine-inning baseball game. It would have been obvious to one of ordinary skill in the art to have selected an appropriate portion of the game to record and show based on cost and design considerations. The method claimed would naturally be used when the video was produced and played.

As to claim 27: Seasonticket discloses broadcasting over the internet (page1 3<sup>rd</sup> paragraph). See also Rangan et al as applied above.

As to claim 28: The method claimed would occur naturally when the video tape was played. It would have been obvious to one of ordinary skill in the art to have included the method of playing the video tape since this is one of the logical reasons for producing the video. The method claimed would naturally be used when the video was produced and played. There is no patentable novelty in broadcasting a video. The means for display is a matter of design choice. The specification provides no unanticipated results from the various means of display chosen.

As to claim 29: Seasonticket discloses audio commentary (page2 3<sup>rd</sup> paragraph). No criticality is seen in the audio containing an explanation of any substitution of players. It would have been obvious to one of ordinary skill in the art to have included appropriate commentary in order to keep the viewer updated with accurate information and avoid viewer confusion. The method claimed would naturally be used when the video was produced and played.

As to claim 30: See claim 25 rejection.

As to claim 31: See claim 26 rejection.

As to claim 32: See claim 27 rejection.

As to claim 33: See claim 28 rejection.

As to claim 34: See claim 29 rejection.

As to claim 35: See claim 23 rejection. Although claim 23 does not include the explicit step of offering the edited video for viewing, it would have been obvious to one

of ordinary skill at the time of the invention to have included the step of offering the edited video in order to increase the satisfaction of the viewer by giving them a choice to view or not view the video. The method claimed would naturally be used when the video was produced and played.

As to claim 36: See claim 27 rejection.

As to claim 37: See claim 29 rejection.

As to claim 38: See claim 23 rejection. Although claim 23 does not include the explicit step of offering the edited video for viewing, it would have been obvious to one of ordinary skill at the time of the invention to have included the step of offering the edited video in order to increase the satisfaction of the viewer by giving them a choice to view or not view the video. The method claimed would naturally be used when the video was produced and played.

As to claim 39: See claim 27 rejection.

As to claim 40: See claim 29 rejection.

Also,

Claims 23-40 are rejected under 35 U.S.C. 103(a) as obvious over Historicfilms in view of Rangan et al. Historicfilms discloses edited baseball films from the 1920-40's ( The video can be played at the cited website). It would have been obvious to one of ordinary skill in the art at the time of the invention to have edited and recorded the video to reflect what the viewer wished to record based on personal preferences. Since the primary means for news in that day was the movie short, the entire game would be filmed and the critical plays would be edited into a film. The short clip shown by Historicfilms is a

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compilation of some of these news films. The method claimed would naturally be used when the video was produced and played. Although Historicfilms sells these films, it makes no reference to a subscription service. Rangan et al discloses the use of subscribers is well known in the art (5:50-64,23:32-40). It would have been obvious to one of ordinary skill in the art at the time of the invention to included obtaining subscribers in order to increase the profitability of the business.

As to claim 24: See claim 23 rejection. The decisions to record each appearance at bat for every player, the final pitch thrown to each player and successful and unsuccessful attempts by the base runners are design choices based on editing decisions by the editor. The specification provides no unexpected or surprising results in recording the action plays of the game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have edited the video to reflect what the editor wished to record based on personal preferences. The method claimed would naturally be used when the video was produced and played.

As to claim 25: The length of time recorded is considered a design choice. No criticality is seen in the duration of the edited recording. The duration of the edited recording is a matter of design choice. The specification provides no unexpected or surprising results in using a edited recording of about 15 minutes. It would have been obvious to one of ordinary skill in the art to have selected an appropriate length of time for the video to run based on cost and design considerations. The method claimed would naturally be used when the video was produced and played.

As to claim 26: The portion of the game recorded is considered a design choice. No criticality is seen in the portion of the game recorded. The portion of the game recorded is a matter of design choice. The specification provides no unexpected results for recording a portion of a nine-inning baseball game. It would have been obvious to one of ordinary skill in the art to have selected an appropriate portion of the game to record and show based on cost and design considerations. The method claimed would naturally be used when the video was produced and played.

As to claim 27: Historicfilms discloses broadcasting over the internet (see and play webpage). See also Rangan et al as applied above. The method claimed would naturally be used when the video was produced and played.

As to claim 28: The method claimed would occur naturally when the video tape was played. It would have been obvious to one of ordinary skill in the art to have included the method of playing the video tape since this is one of the logical reasons for producing the video. The method claimed would naturally be used when the video was produced and played. There is no patentable novelty in broadcasting a video. The means for display is a matter of design choice. The specification provides no unanticipated results from the various means of display chosen. The method claimed would naturally be used when the video was produced and played.

As to claim 29: Historicfilms discloses audio commentary (see website and play baseball video). No criticality is seen in the audio containing an explanation of any substitution of players. It would have been obvious to one of ordinary skill in the art to have included appropriate commentary in order to keep the viewer updated with



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accurate information and avoid viewer confusion. The method claimed would naturally be used when the video was produced and played.

As to claim 30: See claim 25 rejection.

As to claim 31: See claim 26 rejection.

As to claim 32: See claim 27 rejection.

As to claim 33: See claim 28 rejection.

As to claim 34: See claim 29 rejection.

As to claim 35: See claim 23 rejection. The website viewer must select the video to view.

As to claim 36: See claim 27 rejection.

As to claim 37: See claim 29 rejection.

As to claim 38: See claim 23 rejection. The website viewer must select the video to view after purchasing the rights to use the video..

As to claim 39: See claim 27 rejection.

As to claim 40: See claim 29 rejection.

### ***Response to Arguments***

The specification was amended to include the claim of priority based on provisional Application 60/211208.

Applicant's arguments filed 6/10/05 have been fully considered but they are not persuasive.

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In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge to charge a monetary fee for services is well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to have charged a fee to the subscribers in order to increase the profits of the corporation.

With regards to the statement that "even the MLB" declares that this is a revolutionary and new process: The use of hyperbole is well known in the advertising

art. The mere comment made in an advertising promotion does not inherently create a factual statement.

With regard to the assertion that this is a novel invention, the editing of sports events and showing of this edited version for monetary sums is not valid. In doing a further search on the web for condensed video sports games, there is some evidence that the Raptors Basketball Team was showing a condensed version of their games back in 1999-2000. The comment section on page 1 of the Geek.com webpage shows that the Raptors condensed their games down to 1 hour in length. The Raptors web page appears to show that these videos were available during the 1999-2000 season. The archived web page does not permit the viewing of the films. The current method claimed in the instant invention merely changes this 1 hour condensed video to 15 minutes. This is an obvious variation of the method given the choice of the length of time for the condensed video is a design choice.

As noted in a prior office action, the method claimed in this application merely takes a well known procedure (editing tapes) and applies the end result of the editing process to a subscription service. Simply editing the tape to get a desired content is simply the choice of the editor and carries no patentably distinct inventive concept. Charging for a subscription service for viewing this edited tape is a well known obvious variation.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

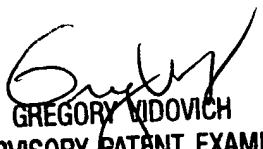
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 571-272-4407. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 23, 2005

  
GREGORY VIDOVICH  
SUPERVISORY PATENT EXAMINER  
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Michael Chambers  
Examiner  
Art Unit 3711